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HEWLETT PACKARD COMPANY
P O BOX 272400, 3404 E. HARMONY ROAD
INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400

EXAMINER

LANEAU, RONALD

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3714

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/965,405

Applicant(s)

GUY ET AL.

Examiner

Ronald Laneau

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15, 17-19 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15, 17-19 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>08152006</u> . | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. The amendment filed on 8/8/06 has been entered. Claims 14, 16, 20, 21 and 23 have been canceled and claims 1-12, 17 and 18 are now pending.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-12, 15, 17-19 and 22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to nothing more than abstract ideas. To be legible for a patent, claims that set forth subject matter excluded by a judicial exception (i.e. abstract idea) must be for a practical application. A practical application results if the claimed invention transforms an article or physical object to a different state or thing or if the claimed invention produces a useful, concrete or tangible result. However, claims 1-23 fail to transform an article or physical object to a different state or thing and the claimed invention as shown by claims 1-23 fail to produce a useful, concrete or tangible result as discussed in detail below.

As to claims 1-12, the claim is directed to a method of doing business comprising: entering into a contract relationship between organizations and authorizing the various entities to perform certain functions. However, the claim is not directed to processing an order or transaction. The claim recites various duties and obligations of the organizations that are parties to the contract. It does not appear that the claim is directed to a practical application of a judicial exception. In order for the claim to be directed to a practical application of a judicial exception, a

useful, concrete and tangible result is produced. In order for the claim to be tangible the claim must set forth a practical application to produce a real world result. If the result is merely a thought, this is not a tangible or real world result. In claim 1, the claim is directed to various conditions that must be met in order for organizations to carry out various functions. The claim does not produce a real world result. Therefore, the claim is non statutory.

As to claims 13, 15 and 17, the claim is directed to a method of doing business comprising establishing requirements for organizations regarding the sale of items and listing the various responsibilities of each of the organizations. However, the claim is not directed to processing an order or transaction. The claim is directed to various conditions that must be met in order for organizations to carry out various functions. The claim does not produce a real world result. Therefore, the claim is non statutory.

As to claim 18, the claim is directed to a method of doing business comprising establishing requirements for organizations regarding the sale of items, listing the various responsibilities of each of the organizations and notification requirements for each of the organizations if certain conditions are met. However, the claim is not directed to processing an order or transaction. The claim does not produce a real world result. Therefore, the claim is non statutory.

As to claims 19 and 22, the claim is directed to a method of doing business comprising: Determining whether an organization providing services has completed the service, determining the types of services provided or to be provided and determining a billing strategy based on this determination. However, the claim is not directed to processing a bill for an order or transaction. The claim does not produce a real world result. Therefore, the claim is non statutory.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6 and 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sharp et al. (hereinafter Sharp), Pat. No. 6,263,317 in view of Radosevich et al; "IT eyes reseller channel change" (hereinafter Radosevich).

As to claim 1, Sharp discloses a method for a first organization to do business comprising: authorizing said second organization to take an order from a customer (i.e. supplier) (col. 3, lines 20-25); receiving payment directly from said customer as a payment for said order taken by said second organization (col. 4, lines 2-4); requiring an organization other than said first organization to ship products not produced by said first organization to said customer (i.e. distribution channel actually used to ship the product (col. 4, lines 36-55). Sharp does not explicitly disclose entering into a contractual relationship with a second organization; said order comprising at least one of: products not produced by said first organization, and services not provided by said first organization requiring an organization other than said first organization to provide services to said customer. However, Radosevich discloses entering into a contractual relationship with a second organization (i.e. reseller agreements) (page 1). Radosevich also discloses said order comprising at least one of: products not produced by said first organization, and services not provided by said first organization (i.e. value added services) (see abstract).

Art Unit: 3714

Finally, Radosevich discloses requiring an organization other than said first organization to provide services to said customer (i.e. resellers ... value added services) (see abstract). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitations as disclosed by Radosevich within Sharp for the motivation of offering additional services not offered by direct sellers thereby providing an incentive and increased choices for customers (i.e. post deployment help) (page 2, paragraphs 15 and 31).

As to claim 2, Sharp does not explicitly disclose The method of claim 1 and further comprising: requiring said second organization to provide a second organization service to a customer. However, Radosevich discloses requiring said second organization to provide a second organization service to a customer (i.e. value added services) (abstract and paragraphs 15 and 17). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitations as disclosed by Radosevich within Sharp for the same motivation as for claim 1 above.

As to claim 3, Sharp does not explicitly disclose the method of claim 1 and further comprising: requiring a third organization to provide a third organization service to said customer. However, Radosevich discloses requiring an organization other than said first organization to provide services to said customer (i.e. resellers ... value added services) (see abstract). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitations as disclosed by Radosevich within Sharp for the motivation stated for claim 1 above.

As to claim 4, Sharp discloses the method of claim 1 and further comprising: requiring a third organization to ship a third organization product to said customer (i.e. alternative supplier with available inventory) (col. 5, lines 29-55).

As to claim 5, Sharp discloses the method of claim 4 wherein said requiring a third organization to ship comprises requiring said third organization to ship said third organization product from a facility not controlled by said first organization (col. 5, lines 5-17).

As to claim 6, Sharp discloses the method of claim 4 and further comprising: verifying that said third organization product was received by said customer (col. 8, lines 58-64).

As to claim 8, Sharp discloses the method of claim 1 and further comprising: tracking receipt of said payment by computer (col. 4, lines 2-8).

As to claim 9, Sharp discloses the method of claim 1 and further comprising: paying said second organization a predetermined amount based on said order (col. 4, lines 1-8).

As to claim 10, Sharp discloses the method of claim 9 and further comprising: tracking said paying said second organization by computer (col. 4, lines 1-8).

As to claim 11, Sharp discloses the method of claim 4 and further comprising: paying said third organization for said third organization product (col. 4, lines 1-8).

As to claim 12, Sharp discloses the method of claim 11 and further comprising: tracking said paying said third organization by computer (col. 4, lines 1-8).

5. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sharp and Radosevich as applied to claim 1 above, and further in view of Hogan (US 2001/0002464 A1).

As to claim 7, Sharp and Radosevich do not explicitly disclose the method of claim 3 and further comprising: verifying that said third organization service was performed by said third organization. However, Hogan discloses verifying that the service was performed by the organization (paragraphs 38 and 41). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitations as disclosed by Hogan within the Sharp and Radosevich combination for the motivation of automating equipment servicing and task management to allow access to maintenance reports (paragraph 12).

6. Claims 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sharp as applied to claim 13 above, and further in view of Carpenter et al (US 6,868,401).

As to claim 13, Sharp discloses a method for a first organization to do business comprising; requiring a second organization to take an order for sales items on behalf of the first organization (i.e. supplier) (col. 3, lines 20-25); in response to a determination that the order includes a product distributed by a third organization sending an order for that product to the third organization (i.e. alternative supplier with available inventory) (col. 5, lines 29-55); requiring the third organization to ship the product directly to a customer's address (i.e. distribution channel actually used to ship the product) (col. 4, lines 36-55). Sharp does not explicitly disclose a notification system but Carpenter discloses invoicing the customer after the physical transfer of the property has been completed. In addition, parties to the transaction are notified of the their financial obligations (col. 5, lines 7-20). As far as the new limitations about product shipped by the third organization is less than all items distributed that were on the order,

Art Unit: 3714

it makes complete sense the product shipped by the third organization is less than the other organization because the third organization is sending only product not carried out by the other organization. Most of products are already met by the first two organization so the third organization is only left with very few products.

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as disclosed in Carpenter within Sharp for the motivation of processing transactions through a computer network and tracks transaction through to completion (col. 2, lines 8-15).

As to claim 15, Sharp does not explicitly disclose The method of claim 14 further comprising: invoicing the customer after the third organization notifies the second organization that the product has been shipped. However, Carpenter discloses invoicing the customer after the physical transfer of the property has been completed. In addition, parties to the transaction are notified of the their financial obligations (col. 5, lines 7-20).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as disclosed in Carpenter within Sharp same reasons given in claim 13.

7. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sharp as applied to claim 13 above, and further in view of Work.

As to claim 17, Sharp does not explicitly disclose the method of claim 13 further comprising: requiring the second organization to notify the first organization when the order is incomplete and when the backlog for items on the order that were not shipped is longer than a

Art Unit: 3714

predetermined number of days. However, Work discloses requiring the second organization to notify the first organization when the order is incomplete (i.e. improper fill rates ... shortages) (paragraphs, 44, 45, 48, and 65) and when the backlog for items on the order that were not shipped is longer than a predetermined number of days (paragraphs, 44, 45, 48, and 65).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as disclosed in Work within Sharp for the motivation of tracking vendor compliance with guidelines imposed on distributors, senders, shippers and the like in a supply chain (paragraph 8).

8. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sharp in view of Bremers (US 6,901,380).

As to claim 18, Sharp discloses a method for a first organization to do business comprising; requiring a second organization to take an order for sales items on behalf of the first organization (i.e. supplier) (col. 3, lines 20-25); in response to a determination that the order includes a product distributed by a third organization sending an order for that product to the third organization (i.e. alternative supplier with available inventory) (col. 5, lines 29-55). Sharp does not explicitly disclose requiring the third organization to notify the first organization when the order exceeds a predetermined credit limit of the second organization. However, Bremers discloses processing business transactions, determining if the order exceeds a predetermined credit limit and presenting the transaction to a user for resolution (i.e. authorizing a higher credit limit) (col. 9, lines 10-20).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as disclosed in Bremers within Sharp for the motivation of a system that provides feedback representing purchase order or customer information changes (col. 2, lines 35-45).

Allowable Subject Matter

9. Claims 19 and 22 are allowed if overcome the 101 rejection.

Response to Arguments

10. Applicant's arguments filed on 8/8/06 have been fully considered but they are not persuasive.

Applicant argues that his invention embodies a result at least useful, concrete and tangible with regards to the 101 rejection. In response to Applicant's arguments, the 101 rejection is made final because Applicant claims a contractual relationship between two organization and wherein a second organization is to take order from a customer. It is not an actual process of ordering and it is mostly an agreement between the two parties where items not carried by a first organization can be ordered from a second organization. The emphasis is on the contractual part and not on the process of ordering. Applicant further argues that Sharp does not disclose "receiving payment directly from said customer as a payment for said order taking by said second organization." In response to Applicant's arguments, Sharp provides evidence of a credit card payment by a customer as shown in col. 4, lines 2-4 so the payment can be provided directly as needed. Furthermore, Applicant argues that Sharp does not discuss "products not

Art Unit: 3714

produced by the first organization.” In response to Applicant’s arguments, this is an inherent feature for the Shark or Radosevich references because it is stipulated in the agreement that the second organization must carry products that are not carried by the first organization. Whatever the agreement is between the two organizations, it must be followed. Furthermore, Applicant argues that the examiner fails to make a prima facie case of obviousness since there is no suggestion or motivation to modify the references or combine reference teachings so as to arrive at the claimed invention. In response to applicant's arguments, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 3714

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald Laneau whose telephone number is (571) 272-6784. The examiner can normally be reached on 7:30 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (571) 272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Ronald Laneau
Primary Examiner
Art Unit 3714

10/12/06